## REMARKS

This responds to the Office Action mailed on June 6, 2006.

Claims 41-44 are added; as a result Claims 22-25 and 32-44 are now pending in this application.

### §112 Rejection of the Claims

Claims 22-25 and 32-40 were rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully traverses these grounds for rejection.

Applicant respectfully points out that the MPEP requires that the first Office Action on the merits should present any non-enablement rejection.[1] In other words, enabled and allowable subject matter should always be looked for and communicated to the Applicant at the earliest opportunity in the prosecution.[2] Making the rejection now, for the first time in this case, suggests that it is an afterthought.

In order to support a *prima facie* case of non-enablement, the Office Action must show a rational basis as to whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.[3] The application need not teach, and preferably omits, what is well known in the art.[4]

Applicant respectfully submits that the specification does provide enablement commensurate with the scope of claims 22-25 and 32-40 for, at least, the following reasons. Applicant's specification beginning at page 5, line 7 and in the description of Figures 3A-5B describes "[fulfilling] a portion of a service request received from a first electronic device, and to send a remaining portion of the service request to a third electronic device found using the

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[1] "In accordance with compact prosecution, if an enablement rejection is appropriate, the first Office Action ..
should present the best case ... so that all such rejections can be withdrawn." MPEP § 2164.04
[2] See Id.
[3] MPEP § 2164.01
[4] See *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991).

registry server." The format and content of messages passed from the second electronic device to the first electronic device are described, as well as the format and content of messages passed from the second electronic device to the third electronic device found, this latter message containing that portion of the service request not fulfilled by the second electronic device. As to the assertion that the scope of the claims allow for the service request to be a service request to have a clothes washer fixed, Applicant respectfully disagrees. "Service request", as used in the computer arts, has a particular meaning with a particular format. As used in the instant application, the services are services that can be performed, at least partially by the electronic device receiving the request. Further, the request for services, and the response to the request, are all contained within the message passed. It could be inferred from the claims and the specification that the service requested could be satisfied, at least partially, by the response itself, without any invocation of other functionality, such as a technician servicing the furnace. Using the Office Action's example, the second electronic device would not be fulfilling the request to service the clothes washer, or to have a furnace fixed.

For at least these reasons, Applicant respectfully requests withdrawal of the § 112, first paragraph, rejection with respect to claims 22-25 and 32-40.

## §*102 Rejection of the Claims*

Claims 22-25, 32-35, and 40 were rejected under 35 USC § 102(b) as being anticipated by Rondeau (U.S. 5,850,433).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.[5] It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*."[6]

Applicant respectfully submits that the Office action give no patentable weight to "fulfill a portion of the service request," as recited in claim 22 and claim 32. As pointed out in the

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[5] *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).
[6] *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

responses filed on September 16, 2005 and February 21, 2006, the system disclosed in Rondeau responds *wholly* to the request for a directory listing. It appears to the Applicant, as previously stated that the system in Rondeau receives a request for a phone number, which it replies to. Applicant sees no basis in fact that would support the assertion that Rondeau could respond partially to the request for a phone number, passing the remainder of the request to another device. As the claim language in claims 22 and 32 recite "fulfilling a portion of the service request," and Rondeau can not perform those functions, Applicant respectfully traverses the rejection. Applicant, in the interests of brevity in the instant response, chooses not to restate the reasons presented in the previous responses, but renews those reasons for withdrawal of the present rejection.

With respect to the claims that properly depend from the above mentioned independent claims, Applicant respectfully submits that a dependent claim incorporates each of the claim elements of the independent claim from which it properly depends, and more. Applicant submits that claims 22-25 and 32-35 are allowable over Rondeau for at least the reasons stated above, and respectfully requests withdrawal of the rejection.

## §*103 Rejection of the Claims*

Claims 36-39 were rejected under 35 USC § 103(a) as being unpatentable over Rondeau (U.S. 5,850,433).

The Office Action rejected claims 36-39 based on Rondeau. Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found Rondeau. Since all the elements of the claim are not found in that patent, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Applicant submits that claims 22-25 and 32-35 are allowable over Rondeau for at least

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 10/027,440
Filing Date: December 20, 2001
Title: ALGORITHM FOR WEB SERVICES FULFILLMENT IN A PEER-TO-PEER ENVIRONMENT
Assignee: Intel Corporation

Page 8
Dkt: 884.623US1 (INTEL)

the reasons stated above, and respectfully requests withdrawal of the §103 (a) rejection.

## *Conclusion*

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-371-2159) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date __10/6/06__          By _____

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexendria, VA 22313-1450 on this __6th__ day of October 2006.

Name  __Amy Morduch__                    Signature _____